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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,787	08/23/2006	Alan Gayne Emblin	187540/US (461124-109)	6382
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Dorsey & Whitney LLP US Bank Center 1420 Fifth Avenue Suite 3400 Seattle, WA 98101-4010			EXAMINER FONSECA, JESSIE T	
			ART UNIT 3633	PAPER NUMBER
			MAIL DATE 04/13/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/568,787	<b>Applicant(s)</b> EMBLIN, ALAN GAYNE
	<b>Examiner</b> JESSIE FONSECA	<b>Art Unit</b> 3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 16 February 2006.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 60-73 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 60-73 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 16 February 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-165/08)  
 Paper No(s)/Mail Date 8/23/06

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining

compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Drawings***

The drawings are objected for the following:

Fig. 9 shows variations of the panels having different stud spacing, each variation embodiment/variation should be shown in separate figures. Further, fig. 9 includes reference numerals and to what appears to be dimensions, it is difficult to ascertain the difference as the dimensions do not include units that would make it readily distinguishable from the reference numerals.

Regarding figures 10-17, the different views must be numbered in consecutive Arabic numerals and each view number must preceded by the abbreviation "FIG." (i.e. Fig. 10a; Fig. 10b; Fig. 10c).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 60-61, 63, and 65-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Durbin (US 4,254,932).

With regards to claims 60, 63, and 68: Durbin discloses a stud (25) capable of use in panel form work for solid filled walls, the stud comprising:

a head (22) formed as a strip (fig. 1) capable of being bonded and/or fastened to an inner face of a panel facing sheet, and

a pair of spaced, opposed flanges (A) formed along and extending away from a central portion of the head (22) the flanges defining a recess (32) with inwardly directed teeth (37) capable of engagement of a spacer element. Examiner notes the central portion of the stud/base is interpreted to be the middle portion along the longitudinal length of the stud.

The recess of Durbin is capable of allowing passage of a suitably dimensioned spacer element, wherein the recess deforms the flanges and causes the inwardly directed teeth to engage the spacer element. Note that any solid material would inherently be able to elastically/plastically deform to certain degree before failure.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding claim 60, Durbin discloses a panel structure comprising the stud (fig. 1).

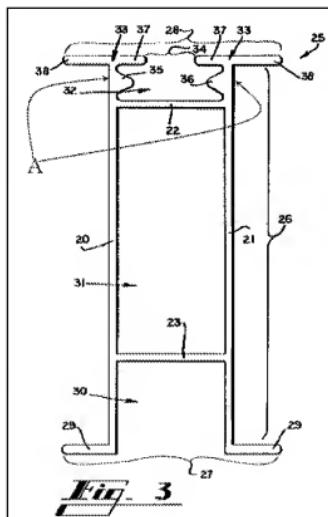


Fig. 3: Durbin (US 4,254,932)

With regards to claim 61: Durbin discloses the width of the head (20-21, 23, 29) is substantially greater than the spacing of the teeth (37) of the flanges on the central portion of the head.

With regards to claim 65: Durbin discloses two or more teeth (35-37) extending longitudinally along each flange (A) inside the recess (fig. 3).

With regards to claim 66: Durbin discloses each flange (A) has an out-turned terminal lip (38) (fig. 3) capable of guiding passage of the spacer element into the recess.

With regards to claim 67: Durbin further discloses the head, flanges and teeth are formed integrally as an extrusion (fig. 3). Note that head, flanges and teeth being formed from extrusion is considered product by process.

Determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP 2113.

Claims 60-64, 67, and 69-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn et al. (US 2002/0124508 A1).

With regards to claims 60, 63, and 68: Dunn et al. discloses a stud (40) capable of use in panel form work for solid filled walls, the stud comprising:

a head (41) formed as a strip (fig. 3A) capable of being bonded and/or fastened to an inner face of a panel facing sheet, and

a pair of spaced, opposed flanges (B) formed along and extending away from a central portion of the head (41), the flanges (B) defining a recess with inwardly directed teeth (inwardly turned flanges) capable engagement of a spacer element.

The recess of Dunn et al. is capable of allowing passage of a suitably dimensioned spacer element, wherein the recess deforms the flanges and causes the inwardly directed teeth to engage the spacer element. Note that any solid material would inherently be able to elastically/plastically deform to certain degree before failure.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding claim 60, Dunn et al. discloses a panel structure comprising the stud (fig. 1A).

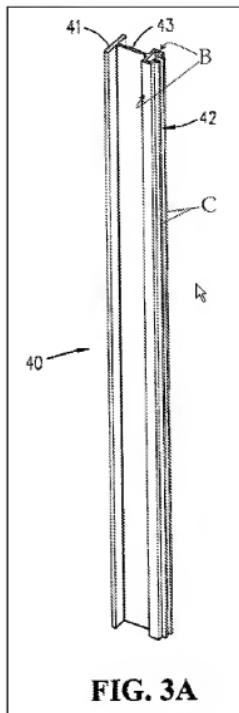


Fig. 3A: Dunn et al. (US 2002/0124508 A1)

With regards to claim 61: Dunn et al. further discloses the width of the head is substantially greater than the spacing of the teeth of the flanges on the central portion of the head (fig. 1B).

With regards to claim 62: Dunn et al. discloses the width of the head (41) is approximately seven times the spacing between the teeth (inwardly turned flanges) of the flange on the central portion of the head.

With regards to claim 64: Dunn et al. further discloses a cross sectional configuration, formed by the strip and the pair of flanges, which is substantially T-shaped (fig. 3A).

With regards to claim 66: Dunn et al. discloses each flange has an out-turned terminal lip (C) capable of guiding passage of the spacer element into the recess.

With regards to claim 67: Dunn et al. further discloses the head, flanges and teeth are formed integrally as an extrusion (fig. 3A). Note that head, flanges and teeth being formed from extrusion is considered product by process.

Determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP 2113.

With regards to claim 69: Dunn et al. further discloses a form work panel for solid filled walls, including:

a pair of facing sheets (11) spaced apart by a plurality of stud assemblies (30, 40),

the stud assemblies (30, 40) each having a pair of parallel strip-like studs (40) held together by a plurality of spacer elements (30),

the studs (40) each having a head (41) attached to a respective panel (11) and a pair of parallel flanges (B) which form a recess extending from a central portion (via web, 43) of the head (41) into the interior of the panel (fig. 4A). Note the recess is considered extending into the interior of the panel as it extends in the direction or toward the interior of the panel. Dictionary.com defines a *into* as "toward or in the direction of: *going into town*."

each spacer (30) in a stud assembly having tongues which engage respective recesses in the pair of studs (fig. 4A), and

each recess in a stud (40) having teeth (inwardly turned flanges formed on the flanges to engage the tongues of the spacer elements (figs. 4A-4B).

With regards to claim 70: Dunn et al. further discloses the head of each stud attached to a respective facing sheet is substantially wider than the width of the spacers (fig. 1B).

With regards to claim 71: Dunn et al. further the width of the head of each stud is more than double the width of the recess formed by the teeth of the flanges (figs. 1B & 3A). Note that the teeth are part of the flanges.

With regards to claim 72: Dunn et al. further discloses a panel according to claim 69, wherein each head has a relatively broad flat surface attached to a respective panel by way of adhesive (claim 2 of Dunn et al.).

With regards to claim 73: Dunn et al. further discloses solid filled wall including a panel as claimed in claim 69 filled with concrete (par. 0021).

Claims 60-64 and 66-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Spera (US 5,233,807).

With regards to claims 60, 63, and 68: Spera discloses a stud capable of use in panel form work for solid filled walls, the stud comprising:

a head (16) formed as a strip capable of being bonded and/or fastened to an inner face of a panel facing sheet, and

a pair of spaced, opposed flanges (274) formed along and extending away from a central portion of the head (16), the flanges (274) defining a recess with inwardly directed teeth (inwardly extending protrusions, best shown in fig. 3) capable engagement of a spacer element.

The recess of Spera is capable of allowing passage of a suitably dimensioned spacer element, wherein the recess deforms the flanges and causes the inwardly directed teeth to engage the spacer element. Note that any solid material would inherently be able to elastically/plastically deform to certain degree before failure.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding claim 60, Spera discloses a panel structure comprising the stud (fig. 1).

With regards to claim 61: Spera further discloses the width of the head (16) is substantially greater than the spacing of the flanges (274) on the central portion of the head (fig. 3).

With regards to claim 62: Spera further discloses the width of the head (16) is approximately seven times the spacing between the flanges (274).

With regards to claim 64: Note that strip and pair of flanges of Spera are substantially T-shaped in cross-section.

With regards to claim 66: Spera further discloses each flange has an out-turned terminal lip (fig. 3) capable of guiding passage of the spacer element into the recess.

With regards to claim 67: Spera further discloses the head, flanges and teeth are formed integrally as an extrusion (fig. 3). Note that head, flanges and teeth being formed from extrusion is considered product by process.

Determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP 2113.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited is directed to concrete forms and/or elongated structural members.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSIE FONSECA whose telephone number is (571)272-7195. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571)272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. F./  
Examiner, Art Unit 3633

/Robert J Canfield/  
Supervisory Patent Examiner, Art Unit 3635